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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,529	12/22/2000	James M. Sheppard JR.	2827	2077

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,529

Applicant(s)

SHEPPARD, JAMES M.

Examiner

Jenna-Leigh Befumo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. The decision by the Board of Appeals and Patent Interferences, filed on July 29, 2004, reversed the rejections set forth by the examiner because the rejection did not explicitly teach the design features related to the location of the border and the printed images. Based on MPEP § 1214.04, which states:

If an examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection.

PROSECUTION IS HEREBY REOPENED due to a new reference, Sherrill et al. (3,721,273) known to the examiner, which was used in a related case, and addresses the issues the Board felt were lacking in the previous rejection. The rejection is set forth below.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 21 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson (4,259,994) in view of Carpenter et al. (5,983,952) and Sherrill et al.

The features of Hobson and Carpenter et al. have been set forth previously in the Examiner's Answer. In the Board's decision, the rejection was overturned because the specific features of a towel having borders at each edge and a different colored central area are not taught in the prior art (decision, pages 4 - 5). The Board does not argue that the rejection is lacking the

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claimed structural features, i.e., two colored yarns forming a woven pattern with different colored sections and a printed pattern forming a printed image on one side of the towel. Instead, the Board feels that the exact placement of the yarns to create a border design and a central area and the placement of the printed image is not taught in the prior art.

Hobson teaches a woven towel made from different color yarns which can be printed with a design pattern prior to weaving to produce an intricate design in the final product. And the figures show that the towel can have different colored regions located at the edges. Further, not only does Hobson explicitly teach that applying print to a towel product can produce intricate jacquard designs in a towel without the expense (column 2, lines 13 – 25), but Hobson also discloses that a towel can be produced with a design on one side, a design on both sides, different colors on opposite sides, and various design patterns produced on the towel including floral and striped designs (column 2, lines 47 – 67).

Therefore, while Hobson teaches the woven towel made from two different colored yarns which can have different colors on opposite sides of the towel, and warp yarns which are pre-printed with a graphic design, Hobson fails to teach explicitly the desired design features claimed by the applicant, i.e., the location of the printed image and the design produced by the different color yarns. However, Hobson clearly suggests that various designs and patterns can be used to produce the finished product.

Additionally, Carpenter et al. provides evidence that towels can be produced on different types of looms to produce decorative designs in the woven fabric by changing the weave pattern of the yarns (column 1, lines 23 – 35). Carpenter et al. also teaches that designs in the weave structure can be combined with printed designs which offers a manufacturer the ability to

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produce fabrics containing many different patterns and colors that have a unique and distinctive appearance (column 1, lines 35 – 42). Thus, Carpenter et al. also discloses the concept of combining weave designs with printed designs to produce various unique and distinctive patterns. And Carpenter et al. discloses that various weave patterns and print patterns would be known to one having ordinary skill in the art. Hence, not only does Carpenter et al. disclose that it is known in the towel art to combine weave patterns with print patterns, but Carpenter et al. also discloses that various patterns and designs are known in the art.

Further, Sherrill et al. is drawn to printed terry cloth towel products. As shown in Figure 1, the towel is produced with the border design on all four edges and a image in the central area created by the border. Thus, Sherrill et al. discloses that the design pattern desired by the applicant, i.e., a border design on all four edges of the towel and image in the center portion of the towel, is known to those in the art. Further, Sherrill et al. discloses that the towel design can be produced by combining a plurality of design areas together (column 3, lines 45 – 50).

Therefore, it would have been obvious to one of ordinary skill in the art to create towels with a known design structure, as shown in Sherrill et al., by combining woven patterns with printed patterns as taught in Carpenter et al. in the fabric of Hobson et al. which teaches creating towels with different colored sections combined with printed patterns to create towels with more intricate designs at a lower cost due to the use of print to create complex designs in the fabric. Also, this would create a towel that is visually and texturally appealing due to the printed images, colors, and weave structure.

Further, in overturning the 35 USC 103 rejection the Board of Appeals argues that the specific features of a towel having borders at each edge and a central area are not taught in the

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prior art (decision, pages 4 - 5). This claimed border feature is created by controlling the location of the colored yarns, and not by changing the overall weave structure of the towel or by adding additional components to the towel. As set forth in § MPEP 1502.01 a “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks (35 U.S.C. 171). The ornamental appearance for an article includes its shape, configuration, and/or surface ornamentation applied to the article. The design pattern created by the two yarns in the woven towel controls the way the fabric looks and does not effect the structure of the towel or the way the towel is used. Hence, the pattern of the colored yarns only effects the ornamentation of the fabric and has no mechanical function at all. Therefore, the location of the different colored yarns, is considered to be a design feature since it only effects how the product looks.

It has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Further, it has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983). In this case, it is felt that there is no functional relationship between the pattern of the colored yarns, i.e., forming a border on each edge, and the woven towel with printing. Because regardless of what color the two sections are, the structure of the towel and how the towel works will not be changed. The only difference between a towel with a blue border section and a white center

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section on the first side, and a towel with a black border section and a yellow center section on the first side, is the appearance of the towel. Even if the towel was a single color or had multiple stripes, instead of a border section on each edge, the towel would still function the same way and have the same structure, i.e., a woven terry cloth towel with a printed design. Hence, the actual design, or location, of the different colored yarns recited in the independent claims should not be given patentable weight because it is not functionally related to the substrate and does not distinguish the invention from the prior art in terms of patentability.

Therefore, the claimed features which deserve patentable weight include, the woven towel having different color yarns which create a first pattern on the a first side and an inverse pattern on the reverse side, and a graphic impression. And as set forth above, these features are taught by Hobson. And with respect to choosing different towel designs and combining printed designs with woven designs, the prior art references disclose combining weave designs with printed designs to create various towel products. Additionally, Hobson et al. discloses that different color yarns can be used and that the towels can have different color sections on opposite sides of the towel. Further, the prior art references also disclose that various patterns can be used in creating aesthetically pleasing towel products and that using various graphic or design patterns is well known in the prior art. Thus, the prior art teaches that various designs and various pattern can be used in combination to form multiple towel designs. Therefore, claims 21 – 36 are rejected.

Conclusion

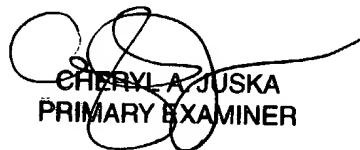
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

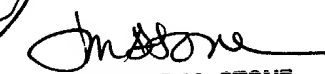
Jenna-Leigh Befumo
September 22, 2004



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